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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,578	06/27/2003	Angelo Bolli	P68915US0	5779
136	7590	09/03/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,578

Applicant(s)

BOLLI ET AL.

Examiner

Barbara L. Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10 and 18-26 is/are rejected.
- 7) ☒ Claim(s) 2,3,8 and 11-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/29/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on July 10, 2002. It is noted, however, that applicant has not filed a certified copy of the EP 02425455.9 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-7, 9-10, 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (EP 1 129 861 A1).
 - a. The image-forming material and planographic original plate taught by Nakamura meets the present respective limitations for the heat-sensitive composition and negative lithographic plate. The image-forming material contains a specific infrared absorber (abstract; [0012]), which meets the present limitations for the same. The image-forming material comprises a polymer soluble in an aqueous alkaline solution such as novolak resins ([0098]-[0104]), which meets the present limitations for the same. The material also comprises a polarity switchable substance which is converted from a lipophilic substance to a hydrophilic substance by heat ([0020]-[0025], [0125]-[0127]). The polarity switchable substance meets the present limitations for the

switchable polymer. The image-forming material may also comprise a printout agent such as a triazine-based compound ([0135]) which meets the present limitations for the same.

4. Claim 25 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zheng et al. (US 5,985,514).

a. In US 5,985,514, Zheng et al. teach an imaging member comprising a hydrophilic imaging layer having a hydrophilic heat-sensitive polymer containing heat-activatable thiosulfate groups. Upon application of energy that generates heat, such as from IR irradiation, the polymer is crosslinked and rendered more hydrophobic (abstract; claim 22).

Allowable Subject Matter

5. Claims 2-3, 8, 11-16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

a. As indicated in the rejection under 102(b) above, Nakamura teach an image forming material in EP 1 129 861 A1 comprising a polarity switchable image-forming material ([0125]). However the polarity switchable image-forming material is converted from a lipophilic substance to a hydrophilic substance, not the reverse which

is required in instant claims 2-3. Additionally the material of Nakamura contains a specific infrared absorber having the specific formula represented by general formula (I). The infrared absorber is required to have at least chromophoric groups ([0021]-[0025]). There is no teaching or suggestion to modify the infrared absorber or of the specific cyanine dye required in present claim 8. The material of Nakamura may also contain a triazine-based print out agent ([0135]). However, there is no teaching or suggestion in the material of Nakamura of the specific triazine compounds required in present claims 11-17.

b. With respect to Zheng et al. (US 5,985,514), there is no teaching or suggestion of a novolak resin or triazine compound in the hydrophilic imaging layer as required in the presently objected claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US 6,602,648 B2 is the same patent family as EP 1 129 861 A1.

b. In US 6,165,679, Van Damme et al. teach a heat-sensitive non-ablatable wasteless imaging element for providing a lithographic printing plate (abstract). There is no teaching of a triazine compound in the imaging element.

c. In US 5,466,557, Haley et al. teach a radiation-sensitive composition containing a resole resin, a novolac resin, a latent Bronsted acid, an infrared absorber and terephthalaldehyde (abstract).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
August 31, 2004